

REMARKS

The Office Action dated July 24, 2006, has been received and carefully considered. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

Applicants note with appreciation the indication on page 4 of the Office Action that claim 5 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have opted to defer rewriting the above-identified claims in independent form pending reconsideration of the arguments presented below with respect to the rejected independent claims.

I. THE ENABLEMENT REJECTION OF CLAIMS 8-10

On page 2 of the Office Action, claims 8-10 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. In particular, the Office Action alleges that the main body and the contact surface are circular or cylindrical in shape and do not form a plane. This rejection is hereby respectfully traversed.

Applicant respectfully submits that claim 8 specifically recites "said contact surface lying in the same plane as and forming an extension of a portion of said outer surface of said main body portion." Applicant respectfully submits that two circular or cylindrical shapes (e.g., two coins) may indeed "lay" in the same plane. For example, a dime lying on a nickel would be coplanar with the nickel. Similarly, Applicant respectfully submits that, as recited in claim 8, the contact surface may in fact "lay" in the same plane as and form an extension of a portion of said outer surface of said main body portion. In any event, Applicant respectfully submits that none

of claims 1, 8, 9 or 10 recites a claim element that is circular or cylindrical in shape.

Accordingly, Applicant respectfully submits that the Examiner's rejection is unfounded.

In view of the foregoing, it is respectfully requested that the aforementioned enablement rejection of claims 8-10 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 1-4 AND 7-11

On page 2 of the Office Action, claims 1-4 and 7-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caspar (U.S. Patent No. 5,339,915) in view of Oxland (U.S. Patent No. 5,676,666). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner alleges that Caspar discloses a bone fixation system in Figure 2 comprising a plate 29 having openings, the openings having a length and width. The Examiner further alleges that Caspar discloses a drill guide comprising first and second guide members each having a passage, offset portions and contact surface pointed to by lead line 8. The Examiner further alleges that a plane may be formed between a portion of the main body and including a portion of the contact surface. In the Response to Arguments Section of the Office

Action, the Examiner alleges that, as illustrated in Figure 1 of Casper, the central axis extends along the shorter portion of the plate between the holes.

Applicant respectfully submits, however, that Casper does not teach or suggest "a plate having a top and bottom surface and *a central axis extending longitudinally between a first end and a second end*, said plate having a plurality of openings between said top and bottom surfaces, wherein *a pair of said openings are first and second slots positioned on opposing sides of said central axis*, said first and second slots each having a width transverse to said central axis and a length extending between first and second ends of said slot in the direction of said central axis, said length being greater than said width," as expressly recited in independent claim 1. In particular, Applicant respectfully submits that Casper does not teach or suggest: (1) a central axis extending longitudinally between a first end and a second end, OR (2) a plurality of openings..., wherein a pair of said openings are first and second slots positioned on opposing sides of said central axis.

Rather, Applicant respectfully submits that Casper merely discloses a bone plate 29 that includes a series of holes, but does not specifically disclose that such holes are "positioned on opposing sides of a central axis," as expressly required by independent claim 1. In fact, Applicant respectfully submits that Casper does not teach or suggest any feature that even remotely comprises "a central axis" extending longitudinally between a first end and a second end of the bone plate 29. Moreover, Applicant respectfully submits that Casper does not disclose a pair of openings that are first and second slots positioned on opposing sides of said central axis. Further, Applicant respectfully submits that the Examiner's allegation in the Response to Arguments section of the Office Action – namely, that the central axis of Casper extends along the *shorter* portion of the plate between the holes – would render the plate disclosed in Casper

inoperative for its intended purpose. That is, the Examiner's proposed modification would require that the plate disclosed by Casper be positioned in a perpendicular relation to the bone or spine, rather than the co-linear relation disclosed in Figure 1 of Casper, for example. As stated in MPEP § 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Accordingly, Applicant respectfully submits that Casper fails to teach or suggest "a plurality of openings..., wherein a pair of said openings are first and second slots positioned on opposing sides of said central axis," as recited in independent claim 1. Thus, Applicant respectfully submits that the proposed combination of the cited references fails to teach or suggest each and every recitation of independent claim 1. Claim 1 is therefore allowable over the cited references.

Claims 2-11 are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2-11 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 2 recites wherein each of said first and second slots defines a recess adjacent said top surface of said plate. Applicant respectfully submits that none of the cited references – alone or in combination – teach or suggest the bone fixation system of claim 1 wherein each of said first and second slots defines a recess adjacent said top surface of said plate.

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In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-4 and 7-11 be withdrawn.

II. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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